

## REMARKS

Continued examination is requested under 37 C.F.R. 1.114.

### I. CLAIM CHANGES

Claim 1 above has been amended to include new features that distinguish its subject matter from the prior art of record. A new independent claim 23, which is similar to canceled claim 17 but contains additional distinguishing features, has been filed.

All claims are now limited to an applicator with two compartments, one containing a hair dye composition and the other containing an oxidizing agent. Applicants are only interested in dyeing hair and an applicator for performing the hair dyeing.

In addition, all claims are limited to an applicator that has means for preventing drying out of the oxidizing agent and hair dye composition. Basis for this limitation is found in the paragraph on page 9, lines 6 to 12, (especially line 11) of applicants' originally filed specification. There must be some way to close the openings 5,6 of the compartments 2,3 to retain the oxidizing agent and hair dye composition at times prior to use, e.g. during storage. This "means for" is embodied in the cap 10 of figures 1 and 3 and in the covering foils 18 of figures 5

and 6. Appropriate dependent claims have been added for both embodiments.

Furthermore dependent claims for the tabs 19, which are used to remove the covering foils 18 so that the hair dye composition and oxidizing agent can be dispensed from the compartments 2,3, have been added.

Amended independent claim 1 has been amended to include insert features from canceled claim 2 and from the specification. It is important to note that the inserts 7,8 do not completely close the product-dispensing openings 5,6; the inserts 7,8 are permeable so that the hair dye composition and the oxidizing agent can pass through them. Furthermore in preferred embodiments they protrude at least slightly from the walls 14,15 of the compartments 2,3 in order to be able to contact a strand of hair during the dyeing procedure. Independent claim 1 has been amended accordingly based on the disclosure regarding inserts on page 4, lines 11 to 19.

Independent claim 23, on the other hand, does not include the feature of the inserts. Instead the insert features are included in dependent claims 24 and 25.

Independent claim 23 has been limited to embodiment of figs. 5 and 6, in which the central compartment is cylindrical and replaceable and the outer compartment is an annular compartment with an annular cross-section. Also the compartments of independent claim 23 are provided with covering foils 18, which can be torn off when the applicator is to be used and which prevent loss of the oxidizing agent and hair dye composition. The covering foils 18 of claim 23 are connected in a light-tight manner with the walls 14,15 of the compartments 2,3.

## **II. ANTICIPATION REJECTION BASED ON KAWASE, ET AL**

Claims 1, 10, and 16 were rejected as anticipated under 35 U.S.C. 102 (b), by Kawase, et al, US Patent 5,848,730.

The additional distinguishing features included in claim 1 have been outlined above in section I.

Kawase, et al, does not disclose or suggest the feature that liquid permeable inserts 7, 8 are inserted in the compartments so as to protrude from the product-dispensing openings. Furthermore canceled claim 2 and other dependent claims containing features regarding the inserts 7, 8 were not rejected as anticipated by Kawase, et al.

It is well established that each and every limitation of a claimed invention must be disclosed in a single prior art reference in order to be able to reject the claimed invention under 35 U.S.C. 102 (b) based on the disclosures in the single prior art reference. See M.P.E.P. 2131 and also the opinion in *In re Bond*, 15 U.S.P.Q. 2<sup>nd</sup> 1566 (Fed. Cir. 1990).

For the foregoing reasons withdrawal of the rejection of amended claims 1, 10, and 16 under 35 U.S.C. 102 (b), by Kawase, et al, US Patent 5,848,730, is respectfully requested.

## **III. Anticipation Rejection based on Bolton**

Claim 17 was rejected as anticipated under 35 U.S.C. 102 (e) by Bolton, US 2004/0161282 A1 (referred to hereinbelow as US '282).

Claim 17 has been canceled, obviating its rejection as anticipated by US '282. However new claim 23 replaces claim 17 and includes many of the same features as claim 17, such as the cylindrical inner compartment surrounded by the annular outer compartment. Also, like claim 17, new claim 23 claims an applicator in which the central cylindrical compartment is replaceable.

Bolton does disclose a marker pen with some of the structural features of claim 23. However Bolton does not disclose the covering foil features shown in applicants' figs. 5 and 6.

Specifically claim 23 contains the feature as follows:

"corresponding covering foils (18) connected in a liquid-tight manner with walls (14,15) of said compartments (2,3) in order to close said product-dispensing openings (5,6) and thus prevent drying out of the oxidizing agent and hair dye composition".

Bolton does not disclose or suggest covering foils that cover or close respective openings of the individual compartments and thus seal the contents, which are later torn off immediately prior to use.

In addition, new claim 23, like claim 1, requires that one container contain a hair dye composition and the other contain an oxidizing agent. The office Action admits on page 4 that Bolton does not disclose an applicator including an oxidizing agent in one compartment and an oxidative hair dye composition in the other compartment.

Thus like claim 1 claim 23 should not be rejected as anticipated.

For the foregoing reasons and because of the additional distinguishing

features in new claim 23, it is respectfully submitted that new claim 23 should not be rejected as anticipated by Bolton, US '282.

#### **IV. Obviousness Rejections of Claims 18 and 19**

Claim 18 was rejected as obvious under 35 U.S.C. 103 (a) over Bolton, US 2004/0161282 A1, (referred to hereinbelow as US '282).

Claim 19 was rejected as obvious under 35 U.S.C. 103 (a) over Bolton, US 2004/0161282 A1, and further in view of Hashimoto, US 5,048,990 (US '990).

Claim 18 has been canceled, obviating its rejection as obvious under 35 U.S.C. 103 (a) over US '282.

Claim 19 has been canceled, obviating its rejection as obvious under 35 U.S.C. 103 (a) over US '282, and further in view of US '990.

#### **V. Obviousness Rejection over Bolton in view of Knight**

Claims 1 to 12 and 20 were rejected under 35 U.S.C. 103 (a) as obvious over Bolton, in view of Knight.

Claim 20 has been canceled and the features of amended claim 1 have been described in section I above.

The Office Action admits that Bolton does not disclose that the dye or ink in one compartment of the pen of Bolton is an oxidative hair dye composition. Bolton also does not disclose that there is an oxidizing agent in the other compartment. The pen of Bolton is provided with separate compartments so that it can draw with different colored inks. See paragraph 0011. Alternatively one

chamber can contain ink and the other chamber can contain an erasing or eradicating medium. See paragraphs 0024, 0071.

Knight is cited for disclosing a pen that has two compartments, one of which contains an oxidizer and the other contains an ink composition with an ingredient that reacts with the oxidizer, when the pen is used to write, i.e. dispense the contents of both compartments.

Knight does not disclose or suggest an applicator for dyeing hair with two compartments, one of which includes an oxidative hair dye composition and the other of which includes an oxidizing agent or oxidizer, as claimed in applicants' claim 1. Knight is concerned with the problem of dating a written text, such as a signature on a legal document, by chemically analyzing the ink in the signature. See column 1, lines 35 to 40; column 2, lines 3 to 32. Thus the oxidizer in the case of Knight must react only slowly over a period of years with the other ingredient of the ink.

The applicants' oxidative hair dye composition is different from the inks or dyes of Bolton and/or Knight. Neither reference teaches that any chamber or compartment should contain an oxidative hair dye composition. An oxidative hair dye composition must react almost instantaneously and very rapidly in the case of the applicants' hair dye applicator to form the colored hair dyeing mixture because it operates by mixing the two components, namely the oxidation hair dye composition and the oxidizing agent directly as they are dispensed on the hair or the hair strand. Thus it must be different from the dye or ink compositions of Knight or Bolton.

Both Knight and Bolton are not concerned with the problem of dyeing hair or dyeing hair strands individually with an applicator, but instead are entirely devoted to pens for drawing or writing with one or more different colored inks. This is a different field of art from that of the applicants. The field of writing instruments, pens or markers, is a different field from the cosmetic arts or devices for performing cosmetic treatments.

Neither Knight nor Bolton disclose or suggest a pen with a compartment including an oxidative hair dye composition. The term "oxidative hair dye composition" has a special meaning in the hair dyeing arts. An oxidative hair dyeing composition is a special form of hair colorant that dyes hair permanently. For example, it is possible to dye black hair blond with oxidative hair dyeing mixtures because of their bleaching effect. These oxidative hair dyeing compositions, by definition as understood by one of ordinary skill in the cosmetic arts, operate by a special mechanism in which a coupler and developer react with each other in the presence of the oxidizing agent to produce a mixture that dyes the hair the desired color.

Although an explicit definition of "oxidative hair dye composition" has not been included in the specification, a copy of a prior art reference, "New Cosmetic Science" that contains a definition of the term "oxidative hair dye composition" is being filed along with this amendment and an information disclosure statement. The definition appears on page 434 of this reference.

The "New Cosmetic Science" reference also describes other categories of dyes, which dye or color hair in a more temporary manner. From this description

of the various dye categories it should be clear that the oxidative hair dye compositions are special types of dyes and that **neither reference or their combination discloses or suggests a pen that contains a oxidation hair dye composition in one compartment and an oxidizing agent in the other compartment.**

It is well established by many U. S. Court decisions that to reject a claimed invention under 35 U.S.C. 103 there must be some hint or suggestion in the prior art of the modifications of the disclosure in a prior art reference or references used to reject the claimed invention, which are necessary to arrive at the claimed invention. For example, the Court of Appeals for the Federal Circuit has said:

"Rather, to establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant... Even when obviousness is based on as single reference there must be a showing of a suggestion of motivation to modify the teachings of that reference.." *In re Kotzab*, 55 U.S.P.Q. 2<sup>nd</sup> 1313 (Fed. Cir. 2000). See also M.P.E.P. 2141

Neither Bolton nor Knight or their combination discloses or suggests the subject matter of amended claim 1, because they do not suggest a pen or applicator that **contains an oxidation hair dye composition in one compartment and an oxidizing agent in the other compartment.**

The fact that the claimed applicator includes the oxidation hair dye composition should not be ignored. Applicants are not merely claiming an applicator structure for mixing two components in general and applying the



mixture. Applicants are claiming a means, namely the claimed applicator, for performing an oxidative hair dye treatment of individual hair strands.

For the foregoing reasons withdrawal of the rejection of amended claims 1, 3, 5, 6, 8, 10 to 12 as obvious under 35 U.S.C. 103 (a) over Bolton, in view of Knight, is respectfully requested.

## **VI. Obviousness Rejection of Claims 13 to 15**

Claims 13 to 15 were rejected under 35 U.S.C. 103 (a) over Bolton, in view of Knight, and further in view of Hashimoto.

Claims 13 and 14 have been amended in a similar manner to state that a covering foil covers or closes the product-dispensing openings and more specifically that:

"the covering foil (18) is connected in a liquid-tight manner with walls (14,15) of said two compartments (2,3)",  
as in the embodiment shown in figures 5 and 6. It is important to note that claims 14 and 15 require the covering foil 18 to be sealed to the walls of the two compartments to provide a liquid-tight closure.

Claim 15 has been amended to limit the means for preventing drying out to the cap 10 of the embodiments shown in figures 1 to 3.

First, Hashimoto does not suggest modifications of the subject matter of Bolton and Knight that are necessary to cure the deficiency mentioned in section IV above. Hashimoto also discloses a pen structure and does not suggest that an oxidative hair dye composition should be used as the dye in the multi-

compartment marker of Bolton or in the pen of Knight.

Second the disclosure in the background section at column 1, lines 28 to 30, of Hashimoto does not suggest the features in e.g. dependent claim 13. Hashimoto discloses that there are two classes of cap-less writing instruments. In the first class of cap-less pens the drying of the ink is prevented by improving the ink or the air hole (column 1, lines 18 to 21). Then the Hashimoto reference continues to state that because of that (in column 1, lines 28 to 31):

"the writing member must be wrapped with aluminum foil or the like separately from the writing instrument body".

In other words, the Hashimoto reference at column 1, lines 28 to 31, would lead one skilled in the art to wrap the entire applicator in aluminum foil. This is not the same as closing the openings product-dispensing spot 4 by

"connecting the covering foil in a liquid-tight manner with walls 14, 15 of the two compartments", as claimed in applicants' amended claims 13 and 14.

The entire applicator or pen could easily be wrapped with aluminum foil without connecting the aluminum foil to the walls 14, 15 of the two compartments.

Hashimoto does not suggest this latter feature of amended claims 13 and 14, because the Hashimoto reference discloses and claims an entirely different mechanism to provide a cap-less pen, which involves a complex internal structure with mechanical means for moving a seal cover into and out of a closure position on a cylinder 3 through which the writing member 8 moves.

As far as amended claim 15 goes, Hashimoto, et al, only discloses capless pens and claim 15 has been amended to include a cap 10 as closure means.

For the foregoing reasons withdrawal of the rejection of amended claims 13 to 15 under 35 U.S.C. 103 (a) over Bolton, in view of Knight, and further in view of Hashimoto, is respectfully requested.

Claims 13 and 14 were rejected under 35 U.S.C. 103 (a) over Kawase, et al, in view of Hashimoto, et al.

Hashimoto, et al, of course do not disclose or suggest the modifications of Kawase, et al, that are necessary to obtain the invention as claimed in claim 13 for example for the foregoing reasons.

First Hashimoto, et al, do not disclose or suggest any liquid permeable inserts that protrude through the product-dispensing openings, as claimed in amended claim 1. These features are disclosed in neither Kawase, et al, nor Hashimoto, et al.

Second, Hashimoto, et al, does not disclose or suggest the features of amended claims 13 and 14, namely the covering foil 18 connected in the manner as claimed in claims 13 and 14.

For the foregoing reasons withdrawal of the rejection of amended claims 13 to 14 under 35 U.S.C. 103 (a) over Kawase, et al, in view of Hashimoto, is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects to put this case in condition for final allowance, then it is requested that such amendments or corrections be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing the case to allowance, he or she is invited to telephone the undersigned at 1-631-549 4700.

In view of the foregoing, favorable allowance is respectfully solicited.

Respectfully submitted,

  
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